

Remarks

Applicant has canceled claim 22. The Examiner correctly noted that this claim should be marked as “withdrawn” in view of the election of claims made by Applicant. Applicant thus has canceled claim 22 as non-elected subject matter. No new matter has been added.

Rejections Under 35 U.S.C. § 102(e)

The Examiner maintained the rejection of claims 1-15, 17-21, 23, 24, 38-45, 47 and 92 under 35 U.S.C. § 102(e) as anticipated by Fire et al. (US 6,506,559 B1). Applicant respectfully traverses the rejection.

The Examiner asserts that the filing date of the Fire provisional application (US 60/068,562, filed December 23, 1997), serves as the 102(e) date for the Fire patent. Therefore, the Examiner concludes that the Fire patent has an earlier effective filing date than our application.

Applicant respectfully disagrees and requests reconsideration on the basis that the disclosure of the Fire provisional application is insufficient as a matter of law under 35 USC § 112, first paragraph, to serve as the 102(e) date. In order “[t]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, [a later-filed application] must comply with the written description requirement of 35 U.S.C. § 112.” Lockwood v. American Airlines Inc., 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997)(entitlement to a filing date extends only to that which is disclosed); New Railhead Mfg. v. Vermeer Mfg. Co., 298 F.3d 1290 (Fed. Cir. 2002); see also MPEP § 2136.03(III). Because the Fire provisional application does not disclose the invention now claimed by Applicant (as is alleged for the Fire patent), the Fire patent should not have the benefit of the Fire provisional application filing date with respect to establishing a prior 102(e) date to serve as an anticipatory reference against the instantly claimed invention.

The Fire provisional application contains no disclosure of several steps of claims 1, 3 and 38. Because all claims depend from one or more of these claims, the Fire provisional application is deficient in disclosing one or more limitations of each of the presently pending claims, and thus does not support that aspect of the Fire patent as asserted against Applicant’s claims.

To be more specific, the Fire provisional application does not disclose at least the following steps of claim 1:

- (1) constructing a cDNA or genomic library of the DNA of a *C. elegans* cell or *C. elegans* organism in a vector in an orientation relative to a promoter(s) that initiates transcription of the cDNA or DNA to double stranded (ds) RNA upon binding of a transcription factor to the promoter(s),
- (2) introducing the library into one or more of the *C. elegans* cells or *C. elegans* organisms comprising the transcription factor, and
- (3) identifying a phenotype of the *C. elegans* cell or *C. elegans* organism comprising the library and identifying the DNA or cDNA from the library responsible for conferring said phenotype.

The Fire provisional application also does not disclose at least the following steps of claim 3:

- (1) cloning a homologue or fragment of a known DNA sequence in a *C. elegans* cell or *C. elegans* organism into a vector in an orientation relative to a promoter(s) that initiates transcription of dsRNA from the DNA homologue or fragment upon binding of a transcription factor to the promoter(s), and
- (2) introducing the vector into said *C. elegans* cell or *C. elegans* organism that comprises the transcription factor.

The Fire provisional application also does not disclose at least the following steps of claim 38:

- (1) providing a construct including a DNA encoding a protein identified in the two hybrid vector experiment, which construct is such that the DNA is orientated relative to a promoter(s) that initiates transcription of the DNA to double stranded RNA upon binding of a transcription factor to the promoter(s), and
- (2) transforming a *C. elegans* cell or *C. elegans* organism comprising the transcription factor with the construct.

Applicant notes that in the Fire provisional application “introduction” of dsRNA is always carried out through injection (or the like) of the dsRNA *per se* into the worm. In contrast, in Applicant’s pending claims, a cDNA or genomic library (claim 1) or a vector (claim 3) or a construct (claim 38) is introduced in *C. elegans*, and transcription of dsRNA may take place in the worm. Thus the Fire provisional lacks at least one essential element of the claimed invention: the introduction of a DNA library, vector or construct into a *C. elegans* cell or *C. elegans* organism.

In view of the foregoing arguments regarding the inadequacy of the Fire patent as a 102(e) reference inasmuch as it depends on the Fire provisional application for an earlier effective filing date, withdrawal of the rejection of the claims under 35 U.S.C. § 102(e) is respectfully requested.

Double Patenting

The Examiner provisionally rejected claims 1-15, 17-21, 23, 24, 38-45, 47, 48 and 92 as unpatentable over claims of copending application 10/057,108 for obviousness-type double patenting.

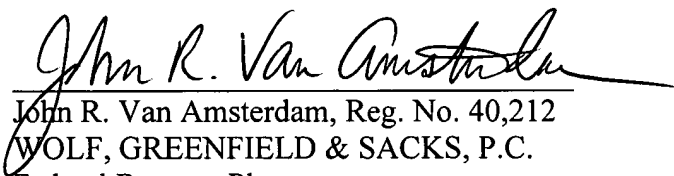
In view of the reasoned statements made above with respect to the only other rejection of the claims, Applicant respectfully believes that the provisional double patenting rejection will be the only remaining rejection of the claims. Accordingly, pursuant to MPEP 804, Applicant respectfully requests that the Examiner withdraw the double patenting rejection of the claims at this time.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Plaetinck, et al., Applicant


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